

# PATENT COOPERATION TREATY

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From the  
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

To:

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## NOTIFICATION OF TRANSMITTAL OF THE INTERNATIONAL PRELIMINARY EXAMINATION REPORT

(PCT Rule 71.1)

Date of mailing  
(day/month/year)

22.09.2004

Applicant's or agent's file reference

x-15822 ✓

### IMPORTANT NOTIFICATION

International application No.

PCT/US 03/23268 ✓

International filing date (day/month/year)

18.08.2003

Priority date (day/month/year)

23.08.2002

Applicant

ELI LILLY AND COMPANY et al.

1. The applicant is hereby notified that this International Preliminary Examining Authority transmits herewith the international preliminary examination report and its annexes, if any, established on the international application.
2. A copy of the report and its annexes, if any, is being transmitted to the International Bureau for communication to all the elected Offices.
3. Where required by any of the elected Offices, the International Bureau will prepare an English translation of the report (but not of any annexes) and will transmit such translation to those Offices.

#### 4. REMINDER

The applicant must enter the national phase before each elected Office by performing certain acts (filing translations and paying national fees) within 30 months from the priority date (or later in some Offices) (Article 39(1)) (see also the reminder sent by the International Bureau with Form PCT/IB/301).

Where a translation of the international application must be furnished to an elected Office, that translation must contain a translation of any annexes to the international preliminary examination report. It is the applicant's responsibility to prepare and furnish such translation directly to each elected Office concerned.

For further details on the applicable time limits and requirements of the elected Offices, see Volume II of the PCT Applicant's Guide.

The applicant's attention is drawn to Article 33(5), which provides that the criteria of novelty, inventive step and industrial applicability described in Article 33(2) to (4) merely serve the purposes of international preliminary examination and that "any Contracting State may apply additional or different criteria for the purposes of deciding whether, in that State, the claimed inventions is patentable or not" (see also Article 27(5)). Such additional criteria may relate, for example, to exemptions from patentability, requirements for enabling disclosure, clarity and support for the claims.

Name and mailing address of the international  
preliminary examining authority:



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# PATENT COOPERATION TREATY

# PCT

## INTERNATIONAL PRELIMINARY EXAMINATION REPORT

(PCT Article 36 and Rule 70)

Applicant's or agent's file reference <b>x-15822</b>	<b>FOR FURTHER ACTION</b> See Notification of Transmittal of International Preliminary Examination Report (Form PCT/IPEA/416)	
International application No. <b>PCT/US 03/23268</b>	International filing date (day/month/year) <b>18.08.2003</b>	Priority date (day/month/year) <b>23.08.2002</b>
International Patent Classification (IPC) or both national classification and IPC <b>C07D265/30</b>		
Applicant <b>ELI LILLY AND COMPANY et al.</b>		
<p>1. This international preliminary examination report has been prepared by this International Preliminary Examining Authority and is transmitted to the applicant according to Article 36.</p> <p>2. This REPORT consists of a total of 5 sheets, including this cover sheet.</p> <p><input type="checkbox"/> This report is also accompanied by ANNEXES, i.e. sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications made before this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions under the PCT).</p> <p>These annexes consist of a total of    sheets.</p>		
<p>3. This report contains indications relating to the following items:</p> <ul style="list-style-type: none"> <li>I    <input checked="" type="checkbox"/> Basis of the opinion</li> <li>II   <input type="checkbox"/> Priority</li> <li>III <input checked="" type="checkbox"/> Non-establishment of opinion with regard to novelty, inventive step and industrial applicability</li> <li>IV   <input type="checkbox"/> Lack of unity of invention</li> <li>V    <input checked="" type="checkbox"/> Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement</li> <li>VI   <input type="checkbox"/> Certain documents cited</li> <li>VII <input type="checkbox"/> Certain defects in the international application</li> <li>VIII <input type="checkbox"/> Certain observations on the international application</li> </ul>		
Date of submission of the demand  <b>01.03.2004</b>	Date of completion of this report  <b>22.09.2004</b>	
Name and mailing address of the international preliminary examining authority:   European Patent Office - Gitschiner Str. 103 D-10958 Berlin Tel. +49 30 25901 - 0 Fax: +49 30 25901 - 840	Authorized Officer  <b>Hoepfner, W</b>  Telephone No. +49 30 25901-337	



**INTERNATIONAL PRELIMINARY  
EXAMINATION REPORT**

International application No. PCT/US 03/23268

**I. Basis of the report**

1. With regard to the **elements** of the international application (*Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report since they do not contain amendments (Rules 70.16 and 70.17)*):

**Description, Pages**

1-81 as originally filed

**Claims, Numbers**

1-15 as originally filed

2. With regard to the **language**, all the elements marked above were available or furnished to this Authority in the language in which the international application was filed, unless otherwise indicated under this item.

These elements were available or furnished to this Authority in the following language: , which is:

- ☐ the language of a translation furnished for the purposes of the international search (under Rule 23.1(b)).  
☐ the language of publication of the international application (under Rule 48.3(b)).  
☐ the language of a translation furnished for the purposes of international preliminary examination (under Rule 55.2 and/or 55.3).

3. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application, the international preliminary examination was carried out on the basis of the sequence listing:

- ☐ contained in the international application in written form.  
☐ filed together with the international application in computer readable form.  
☐ furnished subsequently to this Authority in written form.  
☐ furnished subsequently to this Authority in computer readable form.  
☐ The statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.  
☐ The statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.

4. The amendments have resulted in the cancellation of:

- ☐ the description, pages:  
☐ the claims, Nos.:  
☐ the drawings, sheets:

5. ☐ This report has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed (Rule 70.2(c)).

*(Any replacement sheet containing such amendments must be referred to under item 1 and annexed to this report.)*

6. Additional observations, if necessary:

**INTERNATIONAL PRELIMINARY  
EXAMINATION REPORT**

International application No. PCT/US 03/23268

**III. Non-establishment of opinion with regard to novelty, inventive step and industrial applicability**

1. The questions whether the claimed invention appears to be novel, to involve an inventive step (to be non-obvious), or to be industrially applicable have not been examined in respect of:

- ☐ the entire international application,
- ☒ claims Nos. 6-15 (with respect to industrial applicability)  
because:
- ☒ the said international application, or the said claims Nos. 6-16 relate to the following subject matter which does not require an international preliminary examination (specify):  
  
**see separate sheet**
- ☐ the description, claims or drawings (*indicate particular elements below*) or said claims Nos. are so unclear that no meaningful opinion could be formed (*specify*):
- ☐ the claims, or said claims Nos. are so inadequately supported by the description that no meaningful opinion could be formed.
- ☐ no international search report has been established for the said claims Nos.

2. A meaningful international preliminary examination cannot be carried out due to the failure of the nucleotide and/or amino acid sequence listing to comply with the standard provided for in Annex C of the Administrative Instructions:

- ☐ the written form has not been furnished or does not comply with the Standard.
- ☐ the computer readable form has not been furnished or does not comply with the Standard.

**V. Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement**

1. Statement

Novelty (N)	Yes: Claims	1-15
	No: Claims	
Inventive step (IS)	Yes: Claims	1-15
	No: Claims	
Industrial applicability (IA)	Yes: Claims	1-5
	No: Claims	

2. Citations and explanations

**see separate sheet**

**Re Item III**

**Non-establishment of opinion with regard to novelty, inventive step and industrial applicability**

Claims 6-14 relate to subject-matter considered by this Authority to be covered by the provisions of Rule 67.1(iv) PCT. Consequently, the International Examination Authority fully concurs with the objection put forward by the International Search Authority and no opinion will be formulated with respect to the industrial applicability of the subject-matter of these claims (Article 34(4)(a)(I) PCT).

**Re Item V**

**Reasoned statement under with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement**

Reference is made to the following document:

D1: WO-A-0101973

**Novelty**

The document D1 discloses enantiomeric morpholine derivatives and their use in the treatment of various diseases or conditions such as e.g. pain. The compounds of D1 structurally differ from the compounds of the present claim 1 in that they have oxygen in lieu of sulfur in the side chain and in that the said oxygen atom and the hydrogen atom at position 2 of the morpholine ring are always *trans* in terms of their relative configuration (see pages 4-6, formulae (I), (II), (III), (IV); page 18, line 20 - page 19, line 19).

Consequently, in view of D1, novelty has to be acknowledged for the subject-matter of the present independent claims 1, 6-11 and 15 and the present dependent claims 2-5 and 12-14.

**Inventive step**

The distinguishing feature between the novel subject-matter and D1 can be seen as the particular novel combination of structural and stereochemical features already mentioned above, namely sulfur in lieu of oxygen and *cis*-configuration of sulfur and the neighbouring group R'.

In the absence of any evidence for an unexpected technical effect linked to this feature, the objective problem underlying the novel subject-matter can merely be seen as the provision of further compounds useful in the treatment of various diseases or conditions such as e.g. pain.

However, since the claimed solution to this very general problem, namely the provision of the particular compounds of claim 1 having sulfur in lieu of oxygen and *cis*-configuration of sulfur and the neighbouring group R, was not derivable from D1, the presence of inventive activity has to be acknowledged for the said solution, even in the absence of a technical effect.

This applies even more, since in D1 only reference is made to compounds having *trans*-configuration so that the average artisan trying to find a solution to the above problem would have been rather led away from the said solution.

#### **Industrial applicability**

There is no doubt that the subject-matter of the present claims 1-5 is industrially applicable.

However, for the assessment of the present claims 6-14 on the question whether they are industrially applicable, no unified criteria exist in the PCT Contracting States. The patentability can also be dependent upon the formulation of the claims. The EPO, for example, does not recognize as industrially applicable the subject-matter of claims to the use of a compound in medical treatment, but may allow, however, claims to a known compound for first use in medical treatment and the use of such a compound for the manufacture of a medicament for a new medical treatment.